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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/747,535	12/21/2000	Hanh Kim Le	AUS920000742US1	2079
35525	7590	03/09/2006	EXAMINER	
IBM CORP (YA)			HAQ, NAEEM U	
C/O YEE & ASSOCIATES PC			ART UNIT	PAPER NUMBER
P.O. BOX 802333			3625	
DALLAS, TX 75380			DATE MAILED: 03/09/2006	

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/747,535	LE ET AL.
Examiner	Art Unit	
Naeem Haq	3625	

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 15 December 2005.

2a)  This action is FINAL.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 1,2,5,6,9,10 and 13-16 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1,2,5,6,9,10 and 13-16 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_\_.  
\_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

This action is in response to the Applicants' amendment filed December 15, 2005. Claims 3, 4, 7, 8, 11, and 12 have been cancelled. Claims 1, 2, 5, 6, 9, 10, and 13-16 are pending and will be considered for examination.

Applicants' amendment is sufficient to overcome the objection to claims 1, 5, 9, and 13. The objection is withdrawn.

Applicants' amendment is sufficient to overcome the rejection of claims 1, 2, 5, 6, 9, and 10 under 35 U.S.C. 112 written description requirement. The rejection under written description is withdrawn.

Applicants' amendment is sufficient to overcome the rejection of claims 5 and 6 under 35 U.S.C. 112, 2<sup>nd</sup> paragraph. This rejection is withdrawn.

Applicants' amendment is sufficient to overcome the rejection of claims 5, 6, 9, and 10 under 35 U.S.C. 101. This rejection is withdrawn.

***Final Rejection***

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 5, 9, and 13-16 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling.

Referring to claims 1, 5, and 9: The Applicants' specification discloses that if at least one proxy bid exists which meets or exceeds the bid placed by a first bidder then calculating a proposed bid is critical or essential to the practice of the invention for generating off-increment proxy bids (see specification page 8, line 24 – page 9, line 19; Figure 4B item "432"). An element or process critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). In the present case claims 1, 5, and 9 recite generating off-increment proxy bids that have at least one proxy bid which meets or exceeds the bid placed by a first bidder. However, these claims do not recite the critical or essential feature of calculating a proposed bid as required by the Applicants specification. Therefore these claims stand rejected as being based on a disclosure which is not enabling.

Referring to claim 13: This claim recites an embodiment that has no support in the specification. In particular, the claim is directed to an embodiment having a minimum increment, a first high bid, a proxy bid which is greater than the first high bid

and less than the first high bid plus a minimum increment without the steps of generating an off-increment bid and calculating a proposed bid (see specification page 8, line 13 – page 9, line 19). Since these claims do not recite critical or essential subject matter (i.e. generating an off-increment bid and calculating a proposed bid) necessary to practice the invention, they are deemed to be not enabled by the disclosure. An element or process critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

Referring to claims 14-16: These claims recite the step of calculating a proposed bid. However, the Applicants' specification discloses that this step is performed only for the purpose of generating an "off-increment bid" (see specification page 8, line 13 – page 9, line 19). Since these claims do not recite critical or essential subject matter (i.e. generating an off-increment bid) necessary to practice the invention, they are deemed to be not enabled by the disclosure. An element or process critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**Claims 1, 2, 5, 6, 9, 10 and 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fisher et al. (US 6,243,691 B1).**

Referring to claim 1, Fisher teaches a method and system for generating proxy bids in an electronic auction comprising:

- specifying a minimum increment for bidding on an item (Figure 2; column 5, lines 63-65);
- receiving a bid for said item from a first bidder which is a current high bid for said item (Figure 2; col. 5, lines 61-65);
- identifying a previously recorded proxy bid from a bidder (column 8, line 56 – column 9, line 6);
- generating by said electronic auction an bid which becomes a new high bid for said item utilizing said proxy bid, wherein said another bidder holds the new high bid for said item, further wherein said bid equals said bid received from said first bidder by said minimum increment, and wherein said bid equals said proxy bid (column 8, line 56 – column 9, line 6; column 12, lines 33-61).

Fisher does not teach that the proxy bid from a second bidder is greater than the current high bid. However, Fisher teaches that a plurality of bidders are allowed to establish the limit amount of their proxy bids when the bids are initially placed (column 8, lines 56-60).

Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to allow a bidder to set the limit of the proxy bid to whatever amount the bidder desired (e.g. greater than the current high bid). One of ordinary skill in the art would have been motivated to do so in order to allow the bidder to place a bid that he or she felt was competitive. Fisher does not explicitly teach that the proxy bid from a second bidder is not greater than said current high bid plus said minimum increment. However, Fisher teaches that the proxy bid is equal to the current high bid plus minimum increment (column 8, line 64 – column 9, line 3). The Examiner notes that this reads on the Applicants' claim language because the claim does not preclude the proxy bid from being equal to the current high bid plus the minimum increment. The claim language states only that the proxy bid from a second bidder is "not greater than" said current high bid plus said minimum increment. A proxy bid which is equal to the current high bid plus the minimum increment meets this limitation because it is "not greater than" the current high bid plus said minimum increment. Fisher does not teach that the bid is an off-increment bid or that the bid "does not exceed" the first bid plus minimum increment or proxy bid. However, as already noted above, Fisher teachings read on these limitations because the claim language does not preclude the new bid from being equal to the first bid plus increment or proxy bid. A bid which is equal to the first bid plus the minimum increment or proxy bid meets this limitation because it "does not exceed" the first bid by said minimum increment or proxy bid.

Referring to claims 2, 6, 10, and 14-16, these claims recite comparing a proposed bid to a proxy bid wherein the proposed bid is equal to a minimum increment

plus a current high bid. These claims go on to recite that if proposed bid exceeds the proxy bid then awarding an item to a second bidder for the proxy bid, and if the proposed bid does not exceed the proxy bid then awarding the item to the second bidder for the proposed bid. However, these limitations are inherent in Fisher. Fisher teaches a system and method for conducting proxy bidding for a plurality of bidders. Proxy bidding is inherently designed to allow a bidder to obtain an item for the best possible price up to the proxy bid limit. Therefore, if an auction bid reaches a proxy limit and that bidder has the highest bid then the bidder wins the auction for the proxy bid. However, if the bidder's bid is below the proxy bid and that bidder has the highest bid then the bidder wins the auction for the proposed bid.

Referring to claims 5, 9, and 13: Claims 5, 9, and 13 are rejected under the same rationale as set forth above in claim 1.

### ***Response to Arguments***

Applicants' arguments, with respect to the rejection of claims 1, 5, 9, and 13-16 under 35 U.S.C. 112 enablement, have been considered but they are not persuasive. The Applicants have argued that a rejection under 35 U.S.C. 112, first paragraph is a rejection for elements in a claim that are not supported by the disclosure (see page 8 of "Remarks"). The Examiner respectfully disagrees. 35 U.S.C. 112, first paragraph deals with written description, enablement, and best mode. The Examiner rejected claims 1, 5, 9, 13, and 14-16 under written description and enablement and cited *In re Mayhew* to support the rejection under enablement. For this reason, the Examiner maintains the

rejection of claims 1, 5, 9, and 13-16 under 35 U.S.C. 112, first paragraph for enablement.

Applicant's arguments, with respect to the art rejection of claims 1, 2, 5, 6, 9, 10, 13-16, have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naeem Haq whose telephone number is (571)-272-6758. The examiner can normally be reached on M-F 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn W. Coggins can be reached on (571)-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**Naeem Haq**, Patent Examiner  
Art Unit 3625

March 6, 2006



*Robert M. Pond*  
Primary Examiner